

REMARKS

Claims 1 through 9 are pending in this application. Claims 1 through 5 have been amended and claims 6 through 9 added. Care has been exercised to avoid the introduction of new matter. Specifically, the present Amendment addresses the formalistic issues raised by the Examiner under the second paragraph under 35 U.S.C. § 112. Applicants note that claim 1 has been amended to encompass the embodiment wherein a single burner is employed; whereas, new claim 6 covers the embodiment previously present in claim 1 employing a plurality of burners. The dependency of claim 2 has been appropriately changed. New claims 7 and 8 correspond to original claims 3 and 4 but made dependent upon claim 6. Claim 5 has been amended to encompass the embodiment in comprising a single burner; new claim 9 encompasses the embodiment previously in claim 5 comprising a plurality of burners. Applicants submit that the present Amendment does not generate any new matter issue.

Substitute Specification

Submitted herewith as Exhibit A is a substitute specification. The substitute specification is filed pursuant to 37 C.F.R. § 125(a), as requested by the Examiner, and does not contain any new matter issue but merely corrects the poor quality of the originally filed Application. Appellants regret any inconvenience to the Examiner.

Claims 1 through 5 were rejected under the second paragraph 35 U.S.C. § 112

In the statement of the rejection the Examiner identified various bases perceived to render the claimed invention indefinite. This rejection is traversed.

Applicants do not necessarily agree that one having ordinary skill in the art would have any difficulty understanding the scope of the claimed invention, particularly when reasonably interpreted in light of inconsistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993). However, in order to expedite prosecution, claims 1 through 5 have been amended and new claims 6 through 9 added, addressing the issues raised by the Examiner, with no intention to narrow the scope of the originally claimed inventions.

Specifically, as previously pointed out, in claim 1 the Examiner raised a question with respect to the “(s)” which was intended to mean one or a plurality of burners. For clarification, claim 1 has been amended to encompass the single burner embodiment, and new claim 6 encompasses the use of a plurality of burners.

The Examiner identified a lack of literal antecedent basis for “the direction” in claim 1, line 17, which is addressed by the present Amendment.

The Examiner questioned whether “said marking points” refers to one or more marking points required by the claim. The Examiner also questioned the antecedent basis for the “dummy rod” in lines 15 and 16 of claim 1.

In response Applicants submit herewith as Exhibit B an illustration of a structure encompassed by the claims. It should be apparent that dummy rods are disposed at each end

of a core preform, and each dummy rod has a marking point. Accordingly, there are two marking points located outside of a core preform.

The Examiner raised an issue as to an antecedent basis in claims 3 and 4 for “said starting member end portion side”. Applicants submit that one having ordinary skill in the art would have understood the scope of claims 3 and 4, particularly when reasonably interpreted in light of and inconsistent with the written description of the specification. *Miles Laboratories, Inc. v. Shandon, Inc., supra*. Specifically, the starting member end portion is the blackened portion in Exhibit A. The starting member means the core preform with two dummy rods and the starting member end portion denotes a free side portion of the dummy rod, i.e., a portion far from the core preform beyond the marking point.

At any rate, claims 3 and 4 have been amended to address the issue addressed by the Examiner, and new claims 7 and 8 presented in a similar matter.

The Examiner questioned the antecedent basis for the “soot body formed.” Applicants would refer to the “soot body” appearing in independent 1, line 6.

The present Amendment also addresses the issue raised by the Examiner with respect to “burners” in claim 5, lines 14 and 20.

The Examiner questioned the meaning of “glass material” in claim 5, line 16 and 17. In response claim 5 has been amended to clarify that it is a “glass **raw** material” that is intended. This terminology also appears in new claim 9. In this respect Applicants would refer to page 13 of the written description of the specification, lines 21 and 22, which would have apprised one having ordinary skill in the art that the glass material was intended to encompass the raw materials of glass.

The Examiner also asserted a lack of antecedent basis for said “marking points” in claim 1 and that the “marking points” are indefinite in claims 1 through 5.

Applicants would again refer to Exhibit B stressing that dummy rods are disposed at each end of the core preform. Each dummy rod has a marking point. Accordingly, as one having ordinary skill in the art would have recognized, there were two marking points located outside of the core preform.

Based upon the foregoing Applicants submit that one having ordinary skill in the art would have no difficulty in understanding the scope of claims 1 through 5, and that one having ordinary skill in the art would have no difficulty of understanding the scope of new claims **6 through 9**, when reasonably interpreted in light of and consistently with the written description of the specification. *Miles Laboratories, Inc. v. Shandon, Inc., supra*.

Applicants, therefore, submit the proposed rejection of claims 1 through 6 under the second paragraph 35 U.S.C. § 112 is not viable and, hence, solicit withdrawal thereof. Applicants also submit that claims 6 through 9 comply with the requirements of 35 U.S.C. § 112.

Applicants acknowledge, with appreciation, the Examiner’s indication that claim 1 contains allowable subject matter. Based upon the arguments submitted supra, Applicants submit that all pending claims are a condition for immediate allowance. Favorable consideration, is therefore, respectfully solicited.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'AJS', is written over the printed name of Arthur J. Steiner.

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